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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,052	10/14/2003	Nemat Akbar	018220.000034	5707

7590 06/17/2005

PATTON BOGGS, LLP  
IP Department  
2001 Ross Avenue  
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Dallas, TX 75201

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/685,052

Applicant(s)

AKBAR ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/7/05 Response.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 16-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date See Item 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: IDS 3/14/05, 11/15/04, 10/14/03, .

### DETAILED ACTION

1. Applicant's election of the invention of Group I (Claims 1-16) in the response to restriction requirement filed on March 7, 2005 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Groups (II and III), Claims 17-46 are withdrawn for further consideration.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 8-15 of copending Application No. 11/025,036. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason: The silicone elastomers of Claims 8-15 of the copending obviously read on the compounds of Claims 1-16 of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 9-16 of copending Application No. 11/025,108. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason: The silicone elastomers of Claims 9-16 of the copending obviously read on the compounds of Claims 1-16 of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-4, 7-9, 11 and 14-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 8-10 and 19-20 of copending Application No. 11/025,125. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason: The silicone elastomers of Claims 8-10 and 19-20 of the copending obviously read on the compounds of Claims 1-4, 7-9, 11 and 14-15 of the present invention.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 3-9 and 12-19 of copending Application No. 11/025,175. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason: The silicone elastomers of Claims 3-9 and 12-19 of the copending obviously read on the compounds of Claims 1-16 of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5, 10, 12 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 5 (line 2), Claim 10 (line 7), Claim 12 (line 2) and Claim 16 (line 7), it is not clear as to what “polydimethylvinysiloxane” refers to, because a

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siloxane unit cannot contain both two methyl substituents and one vinyl

substituents.

In Claim 10 (line 2) and Claim 16 (line 2), it is not clear as to how high the “high vinyl silicone gum” is.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-2, 4-5, 8 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Sharabura (US 2003/0165683).

For Claims 1-2, Sharabura discloses a composition comprising a methyl vinyl silicone polymer, a polytetrafluoroethylene, a filler and a crosslinking agent (peroxide). (Table 3) Sharabura is silent on curing the methyl vinyl silicone

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polymer by addition curing technique. However, the instant claims are product-by-process claims. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process” In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). For Claims 4-5, 8 and 11, Sharabura discloses a composition comprising a methyl vinyl silicone polymer, a polytetrafluoroethylene, a filler and a crosslinking agent (peroxide). (Table 3) Note the preamble “A flexible bakeware compound” in the present invention is merely an intended use, and does not carry any weight of patentability. See MPEP 2111.02.

11. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel (US 5 691 067).

Patel discloses a composition comprising a silicone resin, a PTFE, etc. (col. 2, lines 20-33, col. 3, lines 59-65, col. 4, lines 46-51 and Examples) The amount of PTFE is described in col. 4, lines 46-51 and in Coating 10, Coating 18, etc. Patel is silent on curing the silicone resin by addition curing technique. However, the



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instant claims are product-by-process claims. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process” In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Note the preamble “A flexible bakeware compound” in the present invention is merely an intended use, and does not carry any weight of patentability. See MPEP 2111.02.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beale (US 2003/0047838).

Beale teaches the use of a blend of a polysiloxane and PTFE for making flexible bakeware. ([0007], [0021], [0029], [0037] and [0042]) Beale is silent on addition-cured silicone polymer. However, Beale is silent on the curing the blend using addition curing technique. However, the instant claims are product-by-process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Furthermore, Beale is silent on the use of the PTFE in a specific amount set forth in the present claims. However, Beale teaches that the polysiloxane is preferably used in an amount of below 70 wt%. However, Beale further teaches that the more the polysiloxane is used, the less expensive the blend will be. ([0029]-[0030]) Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize more of polysiloxane such as above 85 wt% (i.e., PTFE in amount of no greater than 15 wt%), if the properties of the blend are still acceptable while keeping the cost down. Especially, Applicants do not show the criticality of the PTFE amount.

14. Claims 4-5, 8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beale in view of Hompanera (US 6 197 359).

Beale teaches the use of a blend of a polysiloxane and PTFE for making flexible bakeware, supra, which is incorporated herein by reference. Beale further teaches the use of a filler. The amount of the filler is described in [0031]. Beale is silent on the use of methyl vinyl silicone polymer. However, Hompanera teaches the use of a methyl vinyl polysiloxane for making flexibel bakeware. The motivation is to use the methyl vinyl polysiloxane because of its biocompatibility, etc. (col. 3, llines 19-33) In light of which, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use methyl vinyl polysiloxane in Beale's blend. Hompanera further teaches the cure of methyl vinyl polysiloxane by using a platinum catalyst. (col. 3, lines 33-50) Hompaner is silent on the amount of the platinum catalyst. However, the amount of platinum catalyst will affect the cure rate. In other words, the amount of the platinum catalyst is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to incorporate a platinum catalyst in whatever amount through routine experimentation in order to

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achieve a desired cure rate. Especially, Applicants do not show the criticality of the catalyst amount. See MPEP 2144.05 (II).

15. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beale in view of Hompanera and further in view of Togashi (US 5 232 959).

Beale in view of Hompanera teaches the use of a blend of a polysiloxane and PTFE for making flexible bakeware, *supra*, which is incorporated herein by reference. Beale in view of Hompanera is silent on the specific use of a ground quartz. However, it is well known to incorporate a ground quartz in an addition curing polysiloxane composition. For example, Togashi teaches the use of powdered quartz in an addition curing polysiloxane composition. The motivation of using powdered quartz is to adjust the viscosity, modifying the mechanical properties of the composition, etc. (col. 2, lines 8-39 and col. 6, lines 6-25) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate a ground quartz into Beale's composition.

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16. Claims 7, 9 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beale in view of Hompanera and further in view of Wang (US 6 750 279).

Beale in view of Hompanera teaches the use of a blend of a polysiloxane and PTFE for making flexible bakeware, *supra*, which is incorporated herein by reference. Hompanera teaches the use of a Pt catalyst. (col. 3, lines 34-50)

Hompanera is silent on the specific use of chloro platanic acid. However, it is well known that chloro platanic acid is used as a hydrosilylation catalyst. For example, Wang teaches the use of chloroplatinic (chloroplatanic) acid as a hydrosilylation catalyst. (col. 3, lines 50-60) The motivation of using the chloroplatanic acid is to facilitate the hydrosilylation reaction. In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate a chloroplatanic acid into Hompanera's composition.

Hompanera is silent on the amount of the chloroplatanic acid. However, the amount of chloroplatanic acid will affect the cure rate. In other words, the amount of the chloroplatanic acid is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to incorporate the chloroplatanic acid in whatever amount through routine experimentation in order to achieve a desired cure rate. Especially, Applicants do

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not show the criticality of the chloroplatanic acid amount. See MPEP 2144.05 (II).

Hompanera further teaches the use of a silicone hydride. (col. 3, lines 34-50)

Hompanera is silent on the specific amount of the silicone hydride. However, note that the amount of silicone hydride will affect the properties (e.g., tensile, elongation, hardness, etc.) of the resulting cured material by changing the crosslinking density. In other words, the amount of the silicone hydride is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize silicone hydride in whatever amount through routine experimentation in order to obtain a cured material with desired properties. Especially, Applicants do not show the criticality of the silicone hydride amount. See MPEP 2144.05 (II).

17. Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beale in view of Hompanera and further in view of Togashi, Wang and Hergenrother (US 5 932 649).

Beale in view of Hompanera and Wang and Beale in view of Hompanera and Togashi teaches the use of blends of a polysiloxane and PTFE for making flexible bakeware, supra, which are incorporated herein by reference. Beale further teaches the use of a pigment. Beale is silent on the amount of the pigment.

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However, Beale teaches that the pigment amount can affect the non-stick properties of the blend. ([0031]) In other words, the pigment amount is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a pigment in whatever amount through routine experimentation in order to obtain a blend with proper non-stick properties. Especially, Applicants do not show the criticality of the pigment amount. See MPEP 2144.05 (II). Beale is silent on the use of ethynl cyclohexanol. However, Wang teaches the use of an ethynl cyclohexanol. The motivation to use the ethynl cyclohexanol is to adjust the cure rate. (col. 3, lines 26-49) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate an ethynl cyclohexanol into Beale's blend. Beale is silent on the use of a zinc stearate. However, it is well known that zinc stearate is typically used in a polysiloxane composition. For example, Hergenrother teaches the use of zinc stearate in a polysiloxane composition. The motivation of using zinc stearate is to facilitate processing (i.e., processing aid). (col. 19, lines 14-27) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate zinc stearate into Beale's blend.

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18. The "X" references cited in the international search report are not relied upon because of the following reasons:

US 4 059 378 does not teach or fairly suggest the silicone polymer and the polytetrafluoroethylene set forth in the present invention.

EP 1 197 149 does not teach or fairly suggest the silicone polymer and the polytetrafluoroethylene set forth in the present invention.

US 2002/0171027 does not teach or fairly suggest the silicone polymer and the polytetrafluoroethylene set forth in the present invention.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

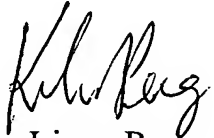
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klp  
June 6, 2005



Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712